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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,014	07/03/2001	Daishi Saiki	862.C2294	9187

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EXAMINER

ZACHARIA, RAMSEY E.

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/897,014	Applicant(s) SAIKI ET AL.	
	Examiner Ramsey Zacharia	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-23 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/13/02; 11/18/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 February 2004 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Language

3. The term "board-shaped" is taken to mean an article having a length greater than its width and a width greater than its thickness.

Claim Rejections - 35 USC § 112

4. Claims 21-23 and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "board-shaped portion" renders claims 21-23 and 28-30 indefinite. While the shape denoted by the term "board-shaped" can be given its traditional meaning, i.e. a shape in

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which the is length greater than the width and the width is greater than its thickness, it is unclear whether "board-shaped portion" refers to the board-shaped part of the entire resin molded product or just the skin layer. As such, it is not clear if the thickness of the projecting portion as claimed is smaller than the thickness of the entire article or smaller than the thickness of the skin layer.

Claim Rejections - 35 USC § 102 / 103

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 21, 22, 28, and 29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Manabe et al. (U.S. Patent 6,068,896).

Manabe et al. teach a molded board-shaped article having a sandwich construction that comprises a skin layer and a core layer (column 3, lines 35-45). In the embodiment of Example 4, the skin layer is formed polypropylene and the core layer is formed of low linear expansion polypropylene. The article may further comprise a boss projecting portion integrally formed on the outside of the article (column 6, lines 23-65). The thickness of the boss is less than the thickness of the article (see Figures 3-7(B), particularly Figures 7(A) and 7(B) that show a tapering thickness to the boss such that at least part of the boss must be thinner than the board-shaped part of the article).

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Manabe et al. do not teach that the resin material for the core layer is a pulverized resin material formed by pulverizing a product molded from a thermoplastic resin material. However, the material for the core layer is a polypropylene, i.e. a thermoplastic resin. The limitation that the material be "formed by pulverizing a molded product" is directed to the process by which the material for the core layer is formed and not the material itself, which is merely a thermoplastic resin. That is, the limitation "formed by pulverizing a molded product" is product-by-process type of limitation. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See MPEP § 2113.

Regarding claim 28, since the thickness of the projecting portion is not greater than the thickness of the board-shaped portion, the relationship between the height of the projection and the thickness of the board-shaped portion is immaterial.

Regarding claims 22 and 28, since the projection is made of a thermoplastic material it will have at least some elasticity because all polymers are visco-elastic materials.

Claim Rejections - 35 USC § 103

7. Claims 21-23 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawashima et al. (U.S. Patent 6,248,412) in view of Manabe et al. (U.S. Patent 6,068,896).

Kawashima et al. teach a molded resin article comprising a boss extending from and formed integral to the surface of the molded article (column 2, lines 32-62). The boss is cylindrically shaped with an open top and has a thickness that is smaller than the thickness of the board-shaped portion of the article (Figures 1A-2). The article may be used as a side molding for an automobile (column 6, lines 28-34).

Kawashima et al. do not teach that the article comprises a core and skin layer.

Manabe et al. is directed to a side molding for an automobile (column 1, lines 7-11). The molding comprises a body with a boss projecting portion integrally formed on the outside of the article (column 6, lines 23-65). The body of the side molding may be constructed of a single material or a core layer surrounded by a skin layer (Figures 3 & 8 and column 3, lines 25-45).

Manabe et al. show that single layer and core/skin constructions are known in the art as equivalent structures for automobile side moldings. Therefore, because these two designs were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute a core/skin structure for the single layer taught by Kawashima et al.

Regarding the limitation that the material be "formed by pulverizing a molded product," this limitation is directed to the process by which the material for the core layer is formed and not the material itself, which is merely a thermoplastic resin. Since this limitation is product-by-process type of limitation, the burden is on the applicant to conclusively demonstrate that the

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product formed by this process results in a materially different product than that of the prior art.

See MPEP § 2113.

Regarding claim 28, since the thickness of the projecting portion is not greater than the thickness of the board-shaped portion, the relationship between the height of the projection and the thickness of the board-shaped portion is immaterial.

Regarding claims 22 and 28, since the projection is made of a resin material it will have at least some elasticity because all resins are visco-elastic materials.

Regarding claims 23 and 30, the cylindrical boss taught by Kawashima et al. can be considered a screw connecting portion since a screw could be inserted therein.

Response to Arguments

8. Applicant's arguments with respect to claims 21-23 and 28-30 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ramsey Zacharia
Primary Examiner
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